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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,520	10/11/2001	Bettina Fath	101216-19	9360
27387	7590	03/24/2004	EXAMINER	
BRUCE LONDA NORRIS, MCLAUGHLIN & MARCUS, P.A. 220 EAST 42ND STREET, 30TH FLOOR NEW YORK, NY 10017			CHANNAVAJJALA, LAKSHMI SARADA	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,520

Applicant(s)

FATH ET AL.

Examiner

Lakshmi S Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Receipt of request for RCE and amendments dated 1-20-04 is acknowledged.

Claims 1-14 are presented for prosecution.

Claim Rejections - 35 USC § 103

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,851,544 to Penska et al (Penska) in view of US 6,328,950 to Franzke et al (Franzke).

Instant claim 1 is an aqueous hair composition, for imparting improved hair styling properties to hair, comprising at least one UV-absorbing substance, green tea extract and at least one mica/titanium dioxide (TiO₂) pigment, whereby at least 90% by weight thereof have a particle size between about 1 to about 250 microns. Claim 2 recites 80% to 90% of the pigment consists of mica and 10% to 20% of the pigment consists of TiO₂. Claim 3 recites mica/TiO₂ pigment in an amount of 0.05% to 5% by weight to the total weight of the composition. Claims 4 and 5 recite the UV absorbing compounds and their amounts from about 0.05% to 2.5%, by weight. Claims 7 and 8 recites amphoteric or zwitterionic surfactants in an amount of 0.1% to 5% by weight of the composition. Claim 9 recites 0.1% to 10% C₁₂-C₁₈ alkyl amidopropyl dimethyl or diethyl amine. Claims 10-14 are directed to a leave-in hair composition comprising the ingredients of claim 1.

Penska teaches a cosmetic composition comprising green tea extract, octyl methoxycinnamate, titanium dioxide, octyl methoxycinnamate and triethanolamine (see example 6 in col. 10). Penska teaches the composition for hair care or skin care and further teaches addition of surfactants such anionic, nonionic, zwitterionic surfactants. Penska clearly teaches

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that their compositions are suitable as leave-on as well as rinse-off compositions and for styling, tonics, conditioning hair (col. 5, lines 10-17). Among the surfactants, Penska mentions alkyl propanolamides such as cocomonoisopropanolamide, cocamidopropyl betaine etc (col. 5, lines 54-67). Penska teaches sunscreen agents such as TiO₂ or zinc oxide, but fails to teach the claimed Mica/TiO₂ particles.

Franzke teaches pigment containing hair styling gel compositions for hair-fixing, coloring the hair as well as imparting brilliant color, hold, shapability and lustrous appearance (col. 1), comprising at least one pigment, a thickener, water, surfactant and a polymer. Among the pigment particles suspended in the composition, Franzke teaches coated pigments such as TIMIRON (col. 3, lines 25-65, particularly lines 25-27 and 64), also employed in the examples of the instant application. Among the surfactants, Franzke teaches betaines as suitable amphoteric surfactants and thus read on claims 8-9 (col. 30-47). Further, Franzke teaches leave-on hair care composition, for producing the desired hair color effect and hair styles (col. 8, lines 49-65). The examples of Franzke teach hair mousse preparation with the claimed amounts of TIMIRON (col. 9). Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to add TIMIRON (mica/TiO₂ pigments) of Franzke in the hair care compositions of Penska comprising green tea extract, octyl methoxycinnamate for leave-on hair coloring or styling effects because Franzke suggests that the pigment particle containing composition impart color to the hair without run off effects on the hair and impart a pleasant appearance, hold and shapability to the hair. Examiner notes that Instant specification also use the same trademark product TIMIRON and accordingly, the percentages of particles claimed are implicit to the product. Further, it would have been obvious for a skilled artisan to

add the amphoteric surfactants, betaine, of Franzke in the composition of Penska and still expect the same emulsification. Furthermore, leaving the composition of Penska containing green tea extract, UV-B absorbing compound (of Penska) and TIMIRON and betaine of Franzke, on the hair without rinsing would have been obvious for a skilled artisan because Franzke suggests leaving the composition on hair and subsequent combing as needed results in the desired hold, shapability of the hair.

RESPONSE TO ARGUMENTS:


Applicants' arguments regarding the previous rejections and unexpected results have been considered but not found persuasive. Applicants argue that Penska teaches compositions with at least 50% wt of carbon dioxide infused fluorocarbons, hair and/or skin care compositions containing green tea extract, TiO₂ & UV blockers, in the form of O/W emulsion. Applicants further argue that Kurz discloses only sunscreen compositions. Applicants argue that even if a composition was suggested by the art for different purposes to solve different problems, unexpected results may still indicate that the prior art was deficient relevant to suggestion to combine the references, such that the combination would have been obvious. In support, applicants state that the examples 1 and 1A on page 11 of the instant specification show that composition comprising mica/TiO₂ particles provided a substantially superior hair styling properties in comparison to composition without the particles. Therefore, applicants argue that even if the teachings of Kurz and Penska were to be combined for different reasons, the instant unexpected results are not demonstrated and because neither reference teaches hair styling benefit, there is no motivation to combine the references. However, instant office action has withdrawn the rejection of claims over a combination of Penska and Kurz and instead presented

a new rejection over the combination of Penska and Franzke et al. Applicants admitted that Penska teaches a hair and/or skin care composition containing green tea extract, TiO₂ & UV blockers. Further, Penska also suggests that the composition is suitable as leave-on, as claimed (col. 5). The new rejection applied includes the teachings of Franzke, which are also directed to leave-on hair compositions comprising claimed TiO₂ and mica particles. Further, Franzke teaches that the composition containing the particles impart hair color resulting in more luster, brightness, shine, holds and shapability, all of which are shown as unexpected in the instant application. Thus, the instant combination of references does teach the unexpected results of instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.30 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lakshmi S Channavajjala
Examiner
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3/19/04